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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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08/30/2004

Michael J. Berardi

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EXAMINER

KAMAL, SHAHID

ART UNIT

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3621

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/810,473	<b>Applicant(s)</b> BERARDI ET AL.	
	<b>Examiner</b> SHAHID KAMAL	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/23/2007, 08/20/2004</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Status of Claims*

1. This Office Action is response to the application filed on August 30, 2004.
2. The claims 1-15 are currently pending and have been examined.

### *CIP*

3. This application is a continuation-in-part ("CIP") application of U.S. application no. 10/192,488 filed on July 9, 2002, now U.S. Patent 7,239,226 ("Parent Application") which claims benefit of application no. 60/304,216 filed on July 10, 2001. See MPEP §201.08. In accordance with MPEP §609.02 *A. 2* and MPEP §2001.06(b) (last paragraph), the Examiner has reviewed and considered the prior art cited in the Parent Application. Also in accordance with MPEP §2001.06(b) (last paragraph), all documents cited or considered 'of record' in the Parent Application are now considered cited or 'of record' in this application. Additionally, Applicant(s) are reminded that a listing of the information cited or 'of record' in the Parent Application need not be resubmitted in this application unless Applicants desire the information to be printed on a patent issuing from this application. See MPEP §609.02 *A. 2*. Finally, Applicants are reminded that the prosecution history of the Parent Application is relevant in this application. See *e.g.*, *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1350, 69 USPQ2d 1815, 1823 (Fed. Cir. 2004) (holding that statements made in prosecution of one patent are relevant to the scope of all sibling patents).

***Claim Objections***

4. Claim 1 is objected to because of the following informalities: in the claim “provide the corresponding account identifier” is repeated. Although it is a typo, it should be fixed. Appropriate correction is required.

***Information Disclosure Statement***

5. The Information Disclosure Statement filed on 23 August 2007 and 20 August 2004 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (US Patent No.: 7,096,204 B1) (“Chen”) in view of Franklin (US Patent No.: 5,883,810) (“Franklin”).

Referring to claim 1, Chen discloses the following:

- a) a transaction device (i.e. secure token) system, said transaction device (i.e. secure token) associated with an account identifier (i.e. true consumer identity), said account identifier (i.e. true

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consumer identity) including at least a first account identifier portion (i.e. true consumer identity) and a second account identifier portion (i.e. true consumer identity), said transaction device (i.e. secure token) further including a transaction device, a first proxy account identifier (i.e. temporary identity) storage area and a second proxy account identifier (i.e. temporary identity) storage area, wherein said proxy account identifier (i.e. temporary identity) storage area is operable to store a proxy account identifier (i.e. temporary identity), wherein said proxy account identifier (i.e. temporary identity) includes said first account identifier portion (i.e. true consumer identity), said second proxy account (i.e. temporary identity) storage area configured to store at least said first account identifier portion (i.e. true consumer identity), said transaction device operable to provide said proxy account identifier (i.e. temporary identity) including said account identifier first portion (i.e. true consumer identity) to an account identifier (i.e. true consumer identity) provider system (see column 1, lines 42-58 –a secure token containing a true consumer identity and the consumer requesting the purchase from the vendor and providing the temporary identity to the vendor, the vendor requesting transaction authorization from the broker by forwarding the request and the temporary identity to the broker, the broker matching the temporary identity to a current list of temporary identities and obtaining the true consumer identity); and

b) an account identifier (i.e. true consumer identity) provider system in communication with said transaction device for receiving said proxy account identifier (i.e. temporary identity) including said account identifier first portion (i.e. true consumer identity), said account provider system operable to associate said account identifier first portion (i.e. true consumer identity) to said account identifier, said account identifier associated with a transaction account, said account

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identifier provider system operable to receive said account identifier first portion (i.e. true consumer identity) and provide the corresponding account identifier, said account provider system operable to provide said account identifier to an account identifier provider server for transaction completion (see column 1, lines 42-58 –a secure token containing a true consumer identity and the consumer requesting the purchase from the vendor and providing the temporary identity to the vendor, the vendor requesting transaction authorization from the broker by forwarding the request and the temporary identity to the broker, the broker matching the temporary identity to a current list of temporary identities and obtaining the true consumer identity and the broker providing authorization for the transaction based on transaction details and true consumer identity).

Chen does not expressly disclose database including a proxy account identifier storage area, said transaction device database proxy account identifier storage area operable for storing a proxy account identifier, said proxy account identifier storage area including.

Franklin discloses database including a proxy account identifier storage area, said transaction device database proxy account identifier storage area operable for storing a proxy account identifier, said proxy account identifier storage area including (see column 8, lines 57-67, column 9, lines 1-4 –the bank computer identify the account information which is store in the database).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Chen to include the step(s) taught by Franklin as discussed above in order to provide a method/system for easy retrieval of the “true consumer identity” by using the proxy identifier as an index (see Franklin: column 9, lines 37-40).

Referring to claim 2, Chen further discloses wherein said account identifier (i.e. true consumer identity) provider system is operable to provide said account identifier to said account identifier provider server (i.e. secure token) in accordance with said account identifier first portion (see column 1, lines 47-49 –the consumer obtaining a temporary identity from the broker by using the true consumer identity from the secure token).

Referring to claim 3, Chen further discloses wherein said account identifier provider system is operable to generate said account identifier second portion in accordance with a predetermined algorithm operated on said account identifier first portion, said account identifier provider system is operable to provide said account identifier to said account identifier provider server in accordance with said account identifier first portion and said generated account identifier second portion (see column 1, lines 42-58 –a secure token containing a true consumer identity and the consumer requesting the purchase from the vendor and providing the temporary identity to the vendor).

Referring to claim 4, Chen does not expressly disclose wherein said account identifier provider system further includes an account identifier provider database, said account identifier provider database operable to store said account identifier, wherein said account identifier provider system is operable to locate said stored account identifier in accordance with a predetermined algorithm operated on said account identifier first portion.

Franklin discloses wherein said account identifier provider system further includes an account identifier provider database, said account identifier provider database operable to store said account identifier, wherein said account identifier provider system is operable to locate said stored account identifier in accordance with a predetermined algorithm operated on said account identifier first portion (see column 8, lines 57-67, column 9, lines 1-4 –the bank computer identify the account information which is store in the database).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Chen to include the step(s) taught by Franklin as discussed above in order to provide a method/system for easy retrieval of the “true consumer identity” by using the proxy identifier as an index (see Franklin: column 9, lines 37-40).

Referring to claim 5, Chen does not expressly disclose wherein said account identifier provider system further includes an account identifier provider database, said account identifier provider database operable to store said account identifier second portion, wherein said account identifier provider system is operable to locate said stored account identifier second portion in accordance with a predetermined algorithm operated on said account identifier first portion, said account identifier provider system is operable to provide said account identifier to said account identifier provider server in accordance with said account identifier first portion and said located account identifier second portion.

Franklin discloses wherein said account identifier provider system further includes an account identifier provider database, said account identifier provider database operable to store said account identifier second portion, wherein said account identifier provider system is



operable to locate said stored account identifier second portion in accordance with a predetermined algorithm operated on said account identifier first portion, said account identifier provider system is operable to provide said account identifier to said account identifier provider server in accordance with said account identifier first portion and said located account identifier second portion (see column 8, lines 57-67, column 9, lines 1-4 –the bank computer identify the account information which is store in the database).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Chen to include the step(s) taught by Franklin as discussed above in order to provide a method/system for easy retrieval of the “true consumer identity” by using the proxy identifier as an index (see Franklin: column 9, lines 37-40).

Referring to claim 6, Chen further discloses a merchant system in communication with said transaction device (i.e. secure token) system, transaction device system operable to provide said proxy account identifier (i.e. temporary identity) to said merchant system, said merchant system in further communication with said account identifier provider system, said merchant system operable to provide said proxy account identifier (i.e. temporary identity) including said account identifier first portion to said account provider (i.e. vendor) system (see column 1, lines 47-50 – consumer get an account identity from a vendor).

Referring to claim 7, Chen further discloses wherein said transaction device (i.e. secure token) system is operable to provide said proxy account identifier in a merchant system recognizable format (see column 1, lines 47-55 -secure token identified with temporary identity).

Referring to claim 8, Chen further discloses a transaction device reader in communication with said transaction device system, said transaction device reader in further communication with said merchant system, said transaction device reader operable to receive said proxy account identifier and to provide said proxy account identifier to said merchant system (see column 1, lines 42-58 -secure token containing true consumer identity and further create a temporary identity for the vendor system).

Referring to claim 9, Chen further discloses wherein said proxy account identifier is in International Standards Organization (ISO) compatible magnetic stripe format (see column 12 lines 6-14 –ISO/IEC).

Referring to claim 10, Chen further discloses wherein said proxy account identifier includes said account identifier first portion in at least one track of an ISO compatible magnetic stripe format (see column 12 lines 6-14 –ISO/IEC).

Referring to claim 11, Chen further discloses wherein said transaction device is operable to provide said proxy account identifier including said account identifier first portion to an account identifier provider system in a contactless transmission medium (see column 1, lines 42-58 –a secure token containing a true consumer identity and the consumer requesting the purchase from the vendor and providing the temporary identity to the vendor, the vendor requesting transaction authorization from the broker by forwarding the request and the temporary identity to the broker,

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the broker matching the temporary identity to a current list of temporary identities and obtaining the true consumer identity and the broker providing authorization for the transaction based on transaction details and true consumer identity).

Referring to claim 12, Chen further discloses wherein said contactless transmission medium is radio frequency (see column 1, lines 45-46 –the medium is a secure token).

Referring to claim 13, Chen discloses the following: receiving a proxy transaction device account identifier (i.e. temporary identity), wherein the proxy transaction device identifier includes at least one portion of a transaction device identifier (i.e. secure token) associated with a transaction account; providing a transaction account identifier (i.e. true consumer) in accordance with a portion of the proxy transaction device identifier (i.e. temporary identity), the portion of the proxy transaction device identifier(i.e. temporary identity) corresponding to a portion of the transaction account identifier; and correlating the transaction account identifier with a transaction account for use in satisfying a transaction (see column 1, lines 42-58 –a secure token containing a true consumer identity and the consumer requesting the purchase from the vendor and providing the temporary identity to the vendor, the vendor requesting transaction authorization from the broker by forwarding the request and the temporary identity to the broker, the broker matching the temporary identity to a current list of temporary identities and obtaining the true consumer identity and the broker providing authorization for the transaction based on transaction details and true consumer identity).

Referring to claim 14, Chen further discloses receiving the proxy transaction device identifier in International Standards Organization magnetic stripe format, wherein the proxy transaction device identifier includes at least a first proxy identifier portion and a second proxy identifier portion, wherein at least the first proxy identifier portion includes a portion of transaction account identifier (see column 12 lines 6-14 –ISO/IEC).

Referring to claim 15, Chen discloses the following: providing a transaction device (i.e. secure token) associated with a proxy account identifier (i.e. temporary identity), the proxy account identifier having at least a first proxy account identifier portion (i.e. temporary identity); associating the first proxy account identifier portion (i.e. temporary identity) with a transaction account identifier (i.e. true consumer identity); the transaction device (i.e. secure token) identifier including first and second transaction account identifier portions (i.e. true consumer); storing the first transaction account identifier portion in the first proxy account identifier portion (i.e. temporary identity); and providing the first transaction account identifier portion (i.e. true consumer) to a transaction account provider for use in determining the transaction account identifier (i.e. true consumer) for use in completing a transaction (see column 1, lines 42-58 –a secure token containing a true consumer identity and the consumer requesting the purchase from the vendor and providing the temporary identity to the vendor, the vendor requesting transaction authorization from the broker by forwarding the request and the temporary identity to the broker, the broker matching the temporary identity to a current list of temporary identities and obtaining the true consumer identity and the broker providing authorization for the transaction based on

transaction details and true consumer identity).

Chen does not expressly disclose a database for storing the proxy account identifier.

Franklin discloses providing a database for storing the proxy account identifier (see column 8, lines 57-67, column 9, lines 1-4 –the bank computer identify the account information which is store in the database).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Chen to include the step(s) taught by Franklin as discussed above in order to provide a method/system for easy retrieval of the “true consumer identity” by using the proxy identifier as an index (see Franklin: column 9, lines 37-40).

8. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the patent examiner should be directed to Shahid Kamal whose telephone number is (571) 270-3272. The Patent examiner can normally be reached on Monday-Thursday (9:00am -7:00pm), Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for this origination where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-directed.uspto.gov>.

Should you have any questions on accessing to the Private PAIR system, contact the Electronic Business Center (EBC) at 1(866) 217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 1(800) 786-9199 (IN USA OR CANADA) or 1(571) 272-1000.

Shahid Kamal  
March 26, 2008

/Jalatee Worjloh/

Primary Examiner, Art Unit 3621